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EXAMINER

CROSS, L

ART UNIT

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1721

3

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/296,217

Applicant(s)

Burts

Examiner

Cross, LaToya I.

Group Art Unit  
1721



☒ Responsive to communication(s) filed on Apr 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 6 contain improper Markusch language. Conventional Markusch language is "selected from the group consisting of A, B, and C". Applicants have recited an alternative to the conventional language which is sufficient except for the use of the phrase "consisting essentially of". It is suggested that Applicants delete the term "essentially".

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,989,673 to Sydansk (herein referred to as Sydansk '673).

Applicant's claimed invention is directed to a lost circulation additive comprising a dry mixture of a water soluble cross-linkable polymer, a cross linking agent, and a reinforcing material selected from fibers and comminuted plant material.

Sydansk '673 teaches a lost circulation fluid comprising a water soluble polymer and a cross linking agent. (See abstract.) The water soluble polymer is a carboxylate containing polymer having one or more carboxylate groups (col. 3, lines 24-36). A preferred water soluble polymer of Sydansk '673 is partially hydrolyzed polyacrylamide, such as recited in instant claim 7 (col. 3, lines 37-54). The cross linking agent is a chromic carboxylate complex, such as recited in instant claim 2 (col. 3, lines 55-64). Sydansk 673 also teaches the additional use of inert solids, such as sand fiberglass, cellulosic fibers, and plastic fibers to enhance the strength of the gel formed from the polymers and cross linking agents (col. 6, lines 57-61). Examples 1-9 of Sydansk '673 further teach the lost circulation fluid described above.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated within the meaning of 35 U.S.C. 102 in view of the teachings of Sydansk '673.

***Claim Rejections - 35 USC § 103***

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,277,760 to Merrill (herein referred to as Merrill '760).

Applicants claimed invention is directed to a lost circulation additive comprising a dry mixture of a water soluble cross-linkable polymer, a cross linking agent, and a reinforcing material selected from fibers and comminuted plant material.

Merrill '760 discloses gels capable of blocking or plugging relatively large openings in permeable formations. The gels of Merrill '760 comprise a partially hydrolyzed carboxylate-containing polymer and a chromic carboxylate complex as a cross linking agent, such as recited in instant claim 2. The preferred hydrolyzed polymer is a partially hydrolyzed polyacrylamide polymer, such as recited in instant claim 7 (col. 2, lines 63-68). Merrill '760 also discloses the use of reinforcing materials which are incorporated into the gels. These reinforcing materials include hydrophilic fibers and hydrophobic fibers. The hydrophilic fibers are those such as glass, cellulose, carbon, silicon, graphite, coke, cotton fibers, and mixtures. The hydrophobic fibers are those such as nylon, rayon, hydrocarbon fibers, and mixtures, such as recited in instant claim 3 (col. 4, lines 14-25).

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Merrill '760 differs from the instantly claimed invention in that there is no specific teaching to the combined use of both hydrophilic and hydrophobic reinforcing materials.

However, since both of the reinforcing materials are disclosed as being used for the same purpose of enhancing the gels formed from the hydrolyzed polymers and cross linking agents, it would have been obvious to one of ordinary skill in the art to combine the two types of reinforcing materials. Absent evidence to the contrary, the use of both types of reinforcing materials (hydrophilic and hydrophobic) would result in an effective additive for use as a lost circulation additive.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 U.S.C. 103, in view of the teachings of Merrill '760.

7. Claims 1, 2, and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,004,553 to House et al (herein referred to as House et al '553) in view of U.S. Patent 3,208,524 to Horner et al (herein referred to as Horner et al '524).

Applicants claimed invention is directed to a lost circulation additive comprising a dry mixture of a water soluble cross-linkable polymer, a cross linking agent, and a reinforcing material selected from fibers and comminuted plant material.

House et al '553 disclose seepage loss fluids for well working applications. The fluids of House et al '553 comprise a combination of reinforcing materials such as oat hulls, corn cobs, cotton, citrus pulp, and cotton burrs. House et al '553 also disclose the conventional use of

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particulates of peanuts, almond, cocoa bean, cottonseed, rice, cotton linters, wool, paper, straw, wood fibers, etc. (col. 2, lines 7-27). House et al '553 disclose the use of the reinforcing particulate material in combination with a crosslinkable polymer (col. 5, lines 1-5). House et al '553 discloses suitable crosslinkable polymer as those described in U.S. Patent 4,722,397 to Sydansk (col. 20-38). The crosslinkable polymers of Sydansk '397 comprise a water soluble carboxylate containing polymer and a cross linking agent such as chromic carboxylate complex, such as instantly claimed by Applicants. (See abstract of Sydansk '397.) House et al '553 further disclose the preparation of the fluids by adding the seepage loss additives to water based well working fluids (col. 5, lines 39-68 and col. 6, lines 1-25).

House et al '553 differ from the instantly claimed invention in that there is no disclosure of the use of cellophane in the seepage loss additives.

Horner et al '524 teach loss circulation fluids similar to those disclosed by House et al '553 in that they comprise crosslinkable polymers. Horner et al '524 teach the employment of bulking agents into the polymer gels to reduce the amount of gel required and to permit the plugging of large fissures which might otherwise be difficult to plug (col. 5, lines 42-48). As bulking agents, Horner et al '524 discloses cellophane and a variety of other fibrous, flaky or granular materials.

Thus, in view of the teaching of the use of cellophane in combination with other fibrous, flaky or granular materials in loss circulation additives for well working fluids, it would have been obvious to one of ordinary skill in the art to employ cellophane as an additional component

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of the loss circulation additive of House et al '553. One of ordinary skill in the art would expect that the addition of cellophane to the fluids of House et al '553 would result in a loss circulation additive similar to that instantly claimed by Applicants, absent evidence to the contrary.

Therefore, for the reasons set forth above, Applicants' instantly claimed invention is deemed to be obvious within the meaning of 35 U.S.C. 103, in view of the teachings of House et al '553 and in view of Horner et al '524.

***Citation of Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached at (703) 308-0756. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC

July 17, 1999

  
ELAINE V. HOWARD  
PRIMARY EXAMINER  
GROUP 1100